IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Joseph ROBERTS, *et al.*

Title: **PROTECTING THERAPEUTIC COMPOSITIONS FROM HOST-MEDIATED INACTIVATION**

Appl. No.: 09/972,245

Filing Date: 10/09/2001

Examiner: Richard A. Schnizer

Art Unit: 1635

REQUEST FOR RECONSIDERATION OF FINALITY

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant requests reconsideration of the finality of the pending action in the above-referenced case. The action asserts a new obviousness rejection based on Boos *et al.*, a publication not previously cited.

There is no justification proffered, however, for advancing a new line of argument in a "final" action. Certainly, nothing about applicant's last claim revisions necessitated the new rejection. To the contrary, the examiner's rationale for invoking Boos bears no apparent relationship to applicant's most recent claim amendments, which simply echo themes already acknowledged by the USPTO in this case. *See, e.g.,* Board Decision of March 26, 2008, pg. 8 (reversing previous obviousness rejection).

When he issued the June 6th Office Action, furthermore, the examiner already had considered substantially the same claim in U.S. SN 12/041908 (*See* claim 1), a continuation of the instant case, as applicant entered here in its December 4th response (*See* claim 1) .

Accordingly, the examiner reasonably could have expected that the recitations at issue here would appear in claims of the instant application. See MPEP § 706.07(a) ("...any

subsequent action on the merits ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed").

In fact, applicant's identification of the examiner's failure to establish a requisite motivation to have combined previously cited prior art appears to have been the examiner's inspiration for issuing a new rejection. See pending action, page 13. Yet, this cannot justify a final action as the vehicle for a new rejection and a related new line of argument over patentability.

Accordingly, the pending action should be reissued as "non-final."

As any petition challenging the finality of the present action must be filed by April 20, 2009, applicant requests Examiner Schnizer to contact the undersigned regarding his reconsideration of his finality decision by 5 pm EDS on **April 16th**.

Respectfully submitted,

Date 13 April 2009 By _____

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